

REMARKS

Reconsideration of the application as amended is requested.

Claims Status

Claims 42, 46, 52, 53, 56-60, 64, 65, and 68-70 are pending. Claims 43-45, 48-50, 54, 55, 61, 62, 66, and 67 are currently canceled; claims 1-41, 47, and 51 were previously canceled. Claims 42 and 63 are amended. No claims are added or withdrawn from consideration in this paper.

§ 112 Rejection

Claims 42-46, 48-50, and 52-70 are rejected under 35 USC § 112, first paragraph, in connection with the recitation “adjacent an edge of the first substrate”.

Although, Applicants respectfully submit that antecedent basis for the subject recitation is found throughout the application, to expedite prosecution claim 42 is amended to remove the recitation. This amendment is made without prejudice to expedite prosecution.

Accordingly, Applicants submit that the rejection under 35 USC § 112, first paragraph, is now moot and should be withdrawn.

§ 102 Rejection

Claims 42, 46, 52-55, and 65-70 are rejected under 35 USC § 102(b) as being anticipated by US Patent Appln. Publn. No. 2002/0179237 (Inagaki et al.).

Claim 42 has been amended to incorporate the recitation of claim 62 therein, thereby rendering the rejection under 35 USC § 102(b) moot.

§ 103 Rejections

Claims 43-45 and 48-50 are rejected under 35 USC § 103(a) as being unpatentable over Inagaki et al. in view of US Patent No. 3,517,106 (Chase).

This rejection is rendered moot by incorporation of the recitation of claim 62 into claim 542.

Claims 56-60 are rejected under 35 USC § 103(a) as being unpatentable over Inagaki et al. in view of US Patent No. 5,924,227 (Sommers).

This rejection is rendered moot by incorporation of the recitation of claim 62 into claim 542.

Claim 61 is rejected under 35 USC § 103(a) as being unpatentable over Inagaki et al. in view of US Patent No. 5,824,415 (Kanki et al.).

This rejection is rendered moot by incorporation of the recitation of claim 62 into claim 542.

Claims 62-64 are rejected under 35 USC § 103(a) as being unpatentable over Inagaki et al. in view of US Patent No. 5,141,790 (Calhoun et al.).

Primary reference Inagaki et al. is admitted in the Office Action to fail to disclose features of former claim 62, which features are now recited in independent claim 42 as amended herein.

In particular, claim 42 recites that the index card has a recess in the second side thereof and that the adhesive is disposed only within the recess. In addition, claim 42 recites that “the recess [has] a depth, relative to an unrecessed portion of the second side of the first substrate, which is sufficient to space the adhesive from the mounting substrate in the absence of the application of the threshold level of pressure”, i.e., the level of the adhesive is recessed below the level of the other portions of the second side.

Primary reference Inagaki et al. does not disclose a recess on the adhesive bearing sheet and thus necessarily fails to disclose that the adhesive is located only within the recess and that the surface of the adhesive is recessed below the level of the other portions of the second side.

This arrangement of adhesive and its relative height to the other portions of the second side of the substrate are critical to operation of the claimed invention.

Even if the proposed combination of references is made, secondary reference Calhoun et al. does not cure the deficiencies of Inagaki et al. First of all, referring to FIG. 1, Calhoun et al. shows adhesive 17 on the back surface of backing 18. Carrier web 12 with dimples 14 therein is used to shape adhesive 17 to have clumps 19 of particles 15 protruding from adhesive 17,

however the carrier is removed from the tape. Adhesive 17 is permanently bonded to backing 18 (col. 5, lines 27-27). Like the primary reference, Calhoun et al. never discloses a construction having adhesive only in recesses on the surface of a substrate, nor arrangement of the relative height of the adhesive being below that of the surrounding portions of the surface of the substrate.

For these reasons, Applicants respectfully submit that the rejection under 35 USC § 103(a) over Inagaki et al. and Calhoun et al. is overcome and that it should be withdrawn.

Claims 42-44, 48, 49, and 68-70 are rejected under 35 USC § 103(a) as being unpatentable over Chase in view of Inagaki et al.

This rejection is rendered moot by incorporation of the recitation of claim 62 into claim 542.

In summary, Applicants respectfully submit that all rejections under 35 USC § 103 have been overcome and should be withdrawn.

CONCLUSION

In view of the above, it is submitted that the application is in condition for allowance.

Respectfully submitted,

14 February 2011
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